APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,857	11/16/2000	William L. Jansen	44439.1.8.1	5894

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EXAMINER
MYHRE, JAMES W

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/714,857	Applicant(s) Jansen et al	
	Examiner James W. Myhre	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Nov 16, 2000* _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-25* _____ is/are pending in the application.

   4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-25* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some* c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

   a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *3&5*

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

U. S. Patent and Trademark Office

PTO-326 (Rev. 04-01)   Office Action Summary   Part of Paper No. 6

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application being

examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35

U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the

amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claims 1-4, 6-12, 14-20, and 22-25 are rejected under 35 U.S.C. 102(e) as being

anticipated by Chien et al (US2001/0054003).

Claim 1: Chien discloses a method for tracking and converting loyalty points, comprising:

a. Obtaining the number of award points awarded to a user under at least one

loyalty program;

b. Converting the user's award points into a credit;

c. Providing access to a retailer that provides discounts based on the credit;

d. Calculating the discount off the price of a selected product or service offered by the retailer; and

e. Applying the discount to the price of the product or service purchased by the user (page 2, paragraphs 0010-0012).

Claim 2: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim 1 above, and further discloses obtaining information about the loyalty program prior to obtaining the award points (page 1, paragraph 0008). The Examiner notes it is inherent that before the award point balance for the user is retrieved (obtained) in Claim 1 that the loyalty program for the user must have been identified. In <u>Chien</u> this is accomplished by the user entering in his charge card number, which is then associated with a loyalty account from which the award point balance is obtained.

Claim 3: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim 2 above, and further discloses that the information is obtained from the user through an interactive communication (page 2, paragraphs 0010-0012).

Claim 4: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim 3 above, and further discloses that the interactive communication is executed over a TCP/IP connection (page 5, paragraph 0039).

Claim 6: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim 3

above, and further discloses converting points from a plurality of loyalty programs (page 4,

paragraph 0033).

Claim 7: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim 6

above, and further discloses using the payment information to complete the purchase (page 2,

paragraphs 0010-0012).

Claim 8: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim 1

above, and further discloses updating the user's credit balance after the purchase of the product or

service (page 2, paragraphs 0010-0012).

Claim 9: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim 8

above, and further discloses storing the award points in a computerized database (page 4,

paragraph 0034).

Claim 10: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

9 above, and further discloses that the loyalty program database is on a remote server (page 4,

paragraph 0034).

Claim 11: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

10 above, and further discloses using computer-to-computer communication to retrieve the

number of award points (page 2, paragraph 0013).

Claim 12: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

11 above, and further discloses the computer-to-computer communication is a database query

(page 2, paragraphs 0009-0013).

Claim 14: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

1 above, and further discloses displaying the current status of the user's credits to the user (page

7, paragraph 0051).

Claim 15: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

1 above, and further discloses updating the award points (page 7, paragraph 0052).

Claim 16: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

15 above, and further discloses updating the award points as a batch communication with the

remote server (page 7, paragraph 0052).

Claim 17: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

16 above, and further discloses verifying the award points (page 7, paragraph 0052).

Claim 18: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

1 above, and further discloses providing information about products or services for sale to the

user via communication with the retailer (page 2, paragraphs 0010-0012).

Claim 19: <u>Chien</u> discloses a method for tracking and converting loyalty points as in Claim

1 above, and further discloses obtaining payment information regarding the user (page 2,

paragraphs 0010-0012).

Claim 20: Chien discloses a method for tracking and converting loyalty points as in Claim

1 above, and further discloses allowing the user to register on-line (page 3, paragraph 0027 and

page 6, paragraph 0049).

Claim 22: Chien discloses a method for tracking and converting loyalty points as in Claim

1 above, and further discloses converting the award points into a proportionate number of system-

wide credits (page 2, paragraph 0009).

Claim 23: Chien discloses a system for tracking and converting loyalty points, comprising:

    a. A database for maintaining credit balances of a user (page 4, paragraph 0034);

    b. An interactive communication link to a loyalty program to which the user has

subscribed (page 3, paragraph 0027 and page 6, paragraph 0049);

    c. An interactive communication link to at least one vendor of a product or service

(page 2, paragraph 0010-0012); and

    d. Computerized means for reducing the credit balance approximately

proportional to a discount offered by the vendor (page 2, paragraphs 0010-0012).

Claim 24: Chien discloses a system for tracking and converting loyalty points as in Claim

23 above, and further discloses linking to a plurality of loyalty programs (page 4, paragraph

0033).

Claim 25: Chien discloses a system for tracking and converting loyalty points as in Claim

23 above, and further discloses linking to a plurality of products or services that the user may

purchase (page 2, paragraph 0010).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 5, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Chien et al (US2001/54003).

        Claims 5 and 21: Chien discloses a method and system for tracking and converting loyalty

points as in Claims 4 and 20 above, but does not explicitly disclose implementing the

communication using HTML and CGI scripts. However, Chien's disclosure that the interactions

may take place over the Internet (page 6, paragraph 0046) and that the user is viewing web pages

online (page 6, paragraph 0050) renders it obvious that the communications are using HTML and

CGI scripts. One would have been motivated to user HTML and CGI scripts during the

communication in view that these are the standard communication protocols used on the Internet.

        Claim 13: Chien discloses a method for tracking and converting loyalty points as in Claim

12 above, but does not explicitly disclose that the database query is submitted as a batch

communication to the remote server. However, Chien does disclose that "any portion of the

process may utilize real-time or batch processing" (page 7, paragraph 0052). Therefore, it would

have been obvious to one having ordinary skill in the art at the time the invention was made to use

batch communications when querying the database. One would have been motivated to use batch

communications in order to eliminate the need for the system to constantly connect and
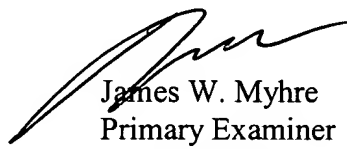
disconnect with the remote server.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The

examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal

or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be

submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM
May 29, 2003

James W. Myhre
Primary Examiner
Art Unit 3622